REMARKS

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-21 are pending in the present application. Claims 1-12, 14, and 16 have been amended. Claims 17-21 are new. Claim 1 is the sole independent claim.

The Examiner is respectfully requested to reconsider the outstanding rejections in view of the above amendments and the following remarks.

Claim for Priority

It is gratefully acknowledged that the Examiner has recognized Applicants' claim for foreign priority. In view of the fact that the claim for foreign priority has been perfected, no additional action is required from Applicants at this time.

Drawings

There is no indication in the Office Action that the Examiner has accepted the Formal Drawings filed on March 23, 2004. It is respectfully submitted that the Formal Drawings comply with the requirements of the USPTO and, as such, no further action is necessary.

Acknowledgment of Information Disclosure Statement

The Examiner has acknowledged the Information Disclosure Statements filed on August 10, 2005 and March 23, 2004. Initialed copies of the corresponding SB08/PTO-1449 forms have been received from the Examiner. No further action is necessary at this time.

Rejections Under 35 U.S.C. § 103

Rao/Justice

Claims 1-3 and 6-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,581,056 to Rao (hereafter "Rao") in view of U.S. Patent Application

Publication No. 2003/0023634 to Justice et al. (hereafter "Justice"). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Initially, the Examiner is respectfully referred to MPEP § 2143.03, which sets forth the following requirements for a proper rejection under 35 U.S.C. § 103:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Applicant respectfully submits that Rao and Justice fail to provide a teaching or suggestion of all of the features in the claimed invention.

As amended, independent claim 1 recites, "performing the markup process of... automatically adding content to the structured document in association with at least one of the meaningful words in order to generate a markup document." Applicants respectfully submit that the proposed combination of Rao and Justice fails to teach or suggest this feature.

In the rejection, the Examiner acknowledges that Rao fails to disclose generating a structured document or performing a markup process (see Office Action at page 4). The Examiner asserts that Justice discloses "transformation processor (element refinement processing unit) for transforming content items (meaningful words) in a text file into [*sic*] markup file that includes metadata such as tags that are associated with a number of content elements" (*Id.*)

However, Applicants respectfully submit that Justice does not teach or suggest *adding content* to a document during the markup process. Instead, Justice merely adds markup tags to the document and relocates existing content elements according to the tags (see, e.g., Justice at Figs. 2 and 3).

Applicants respectfully submit that the Rao/Justice combination fails to teach or suggest each claimed feature. At least for this reason, Applicants submit that claim 1 is allowable, and

claims 2, 3, 6, and 7 are allowable by virtue of their dependency on an allowable claim. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Rao/Justice/Chen

Claims 4 and 8 stand rejected under § 103(a) as being unpatentable over Rao, Justice, and U.S. Patent No. 7,020,685 to Chen et al. (hereafter "Chen"). Applicants respectfully submit that Chen fails to remedy the deficiencies of Rao and Justice as set forth above in connection with independent claim 1. In particular, the Examiner only relies on Chen for teachings regarding translating a document in markup language to a text/plain document (see Office Action at pages 5-6). Thus, it is respectfully submitted that claims 4 and 8 are allowable at least by virtue of their dependency on claim 1. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Rao/Justice/Guck

Claims 5 and 9 stand rejected under § 103(a) as being unpatentable over Rao, Justice, and U.S. Patent No. 5,848,415 to Guck (hereafter "Guck"). Applicants submit that Guck fails to remedy the deficiencies of Rao and Justice set forth above in connection with independent claim 1. Particularly, the Examiner only relies on Guck for teachings regarding converting an email to a plain document (see Office Action at pages 6-7). Thus, it is respectfully submitted that claims 5 and 9 are allowable at least by virtue of their dependency on claim 1. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Rao/Justice/Brooke

Claims 10, 11, 14, and 16 stand rejected under § 103 as being unpatentable over Rao, Justice, and U.S. Patent No. 6,748,569 to Brooke et al. (hereafter "Brooke").

The Examiner asserts, "Brooke discloses markup language (XML) [*sic*] lets authors markup data with author-defined elements (opening and closing pairs of tags) that specify the nature of the

data, and also enables users to create unique tags that identify their information in more meaningful ways" (Office Action at page 8). However, Brooke fails to remedy the deficiencies of Rao and Justice set forth above with respect to independent claim 1. In particular, Applicants submit that Brooke does not teach or suggest, nor does the Examiner assert that Brooke teaches or suggests, adding *content* to a structured document rather than markup tags. Furthermore, the Examiner merely cites portions of Brooke that discuss *letting authors* mark up data and *enabling users* to create unique tags, rather than *automatically* adding data (content) as claimed.

Thus, Applicants submit that claims 10, 11, 14, and 16 are allowable at least by virtue of their dependency on claim 1. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Rao/Justice/Brooke/Ballantyne

Claims 12 and 13 stand rejected under § 103 as being unpatentable over Rao, Justice, Brooke, and U.S. Patent Application Publication No. 2001/0044811 to Ballantyne et al. (hereafter "Ballantyne"). Applicants respectfully submit that Ballantyne fails to remedy the deficiencies of Rao and Justice as set forth above in connection with independent claim 1.

Particularly, Ballantyne teaches modifying program applications of a legacy computer system to output data directly as XML. As such, Ballantyne's markup process is not performed on a received document. Thus, Ballantyne does not teach or suggest adding content to a structured document to generate a markup document, as recited in claim 1.

As such, Applicants submit that claims 12 and 13 are allowable at least by virtue of their dependency on claim 1. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider the outstanding rejections and issue a Notice of Allowance in the present application.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: September 12, 2006

Respectfully submitted,

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